

Remarks

Reconsideration of this Application is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

I. Status of the claims

Upon entry of the foregoing amendment, claims 35-77 are pending in the application, with 35 and 52 being the independent claims. Claims 35, 42 and 52-54 are sought to be amended. New claims 73-77 are sought to be added.

II. Support for New and Amended Claims

The amendment finds support throughout the specification and in the claims as filed.

III. Rejection under 35 U.S.C. § 112, first paragraph

At page 2 of the Office Action, the Examiner rejects claims 35-41, 43-53 and 55-72 under 35 U.S.C. § 112, first paragraph for lack of written description. The Examiner states that "[t]he specification and claims do not describe a representative number of species in the genus comprising any and/or all double stranded nucleic acid molecules that comprise any and/or all repeat-containing sequences having substantially the same percentage of each respective molecule in the bottom and top strands. Applicants respectfully traverse the rejection.

Applicants wish to remind the Examiner that “[a]dequate description under the first paragraph of 35 U.S.C. 112 does not require *literal* support for the claimed invention.” “. . . the observation of a lack of literal support does not, in and of itself, establish a *prima facie* case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112.” *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. Int. 1994). “If a person of ordinary skill in the art would have understood the inventor to have been in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate written description requirement is met.” *In re Alton*, 37 USPQ2d 1578, 1584 (Fed. Cir. 1996). An applicant is not required to disclose or provide a working example of every species of a given genus in order to meet the written description requirement. Subject matter that “might fairly be deduced from the original application” is considered to be described in the application as filed. *Acme Highway Products Corp. v. D.S. Brown Co.*, 431 F.2d 1074, 1080 (6th Cir. 1970), *followed by Westphal v. Fawzi*, 666 F.2d 575, 577 (C.C.P.A. 1981).

Example 1 at pages 17-19 of the specification discloses a method of synthesizing repeat-containing sequences having restriction sites created by the junction of adjacent copies of the repeat-containing sequences. The disclosure in Example 1 allows repeat containing sequences of varying lengths to be synthesized. Additionally, any restriction site can be generated within the repeat-containing sequence by choosing a sequence of nucleotides such that when two adjacent repeat-containing sequences are brought together, a particular restriction site is created. See the exemplary restriction sites set forth on pages 11-13 of the above-captioned application.

Consequently, it is not necessary that every nucleic acid molecule encompassed by the claimed invention be described because the disclosure conveys to one of ordinary skill in the art that Applicants had possession of the claimed invention at the time of filing. Therefore, reconsideration and withdrawal of the 35 U.S.C. § 112, first paragraph written description rejection is respectfully requested.

Rejection under 35 U.S.C. § 102

At page 4 of the Office Action, the Examiner rejects claims 35, 36, 39, 41, 43, 48, 49 and 51 under 35 U.S.C. § 102(b) as being anticipated by the Oncor Catalogue. The Examiner states that the Oncor Catalogue teaches a linear nucleic acid molecule (DNA) comprising two or more copies of a repeat-containing sequence, wherein the top strand of the repeat-containing sequence has substantially the same percentage of each respective nucleotide as in the bottom strand and adjacent copies of palindromic, repeat-containing sequences are separated by a restriction site that generates sticky ends upon digestion. Applicants respectfully traverse the rejection.

Under 35 U.S.C. § 102, a claim can only be anticipated if every element in the claim is expressly or inherently disclosed in a single prior art reference. *See Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984). The Examiner asserts that v-fes, met-D and met-H in the Oncor Catalogue have restriction site-containing sequences that interrupt repeating sequences. However, the DNA probes described in The Oncor Catalogue do not have repeat-containing sequences separated by a restriction site formed by the junction of adjacent copies of the repeat containing sequences. That is, the Oncor Catalogue does not contain, either expressly or

implicitly, every element of the claims. Applicants respectfully submit that the Examiner has thus failed to establish a prima facie case of anticipation.

Additionally, because claims 36, 39, 41, 43, 48, 49 and 51 depend directly or indirectly from claim 35, the Oncor Catalogue cannot anticipate these claims. As a rule, a dependent claim is “construed to incorporate by reference all the limitations of the claim to which it refers.” 35 U.S.C. § 112, paragraph 4 (BNA 2001); *see also Bloom Eng'g Co. v. North Am. Mfg. Co.*, 129 F.3d 1247, 1250, 44 USPQ2d 1859, 1861 (Fed. Cir. 1997). Hence, the dependent claims as well are not anticipated.

Reconsideration and withdrawal of the 35 U.S.C. § 102(b) rejection is respectfully requested.

IV. Objection and Allowable Subject Matter

At page 5 of the Office Action, the Examiner objects to claims 42 and 54 as being dependent upon a rejected base claim, but states that the claims are allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claims 42 and 54 have been amended to make them independent. Therefore, amended claims 42 and 54 are in form for allowance.

Conclusion

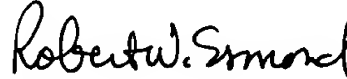
All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for

allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, reading "Robert W. Esmond". The signature is written in a cursive, slightly slanted style.

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